

REMARKS

Claims 1, 2 and 8-15 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. US 6,929,857. The Examiner was not persuaded by the previously submitted remarks, stating that it was reasonable to assume that some of the Watanabe et al. latex would be vulcanized in the presence of vulcanizing agents. The Applicant traverses the Final Rejection as follows.

First, in the first Office Action the Examiner gave no weight to the fact that the claim is to a masking compound. However, the use of a product has patentable weight when the properties of the product would depend on the use. Masking compounds are sacrificial components that are typically applied to protect a part or an area from contact with another compound, e.g., paint, and are then removed from the part or area. Given that Watanabe et al. teach the formation of a permanent coating, the Examiner's presumption that Watanabe could function as a masking compound is dubious and should either be withdrawn or supported with more facts. The doubt over the suitability of the Watanabe et al. compound to function as a masking compound is further reinforced by the fact that the Watanabe compound requires heating to a high (120+ C), which would render it impractical for many masking operations. Moreover, when the Watanabe compound is vulcanized in accordance with embodiments of that invention, it forms a crosslinked film. The Examiner has not provided evidence that such a crosslinked film could then be successfully applied as a masking in accordance with the current invention.

Second, the Examiner has failed to address the issue of whether using a vulcanized latex would be operational, or use a different principle of operation, for the purposes of Watanabe et al. Again, vulcanization, or crosslinking, *in situ* on the glass fiber appears to be a key principle of operation of the Watanabe et al. reinforcing fiber. Any vulcanized rubber in the Watanabe latex would presumably form defects in the desired coating, as these pre-vulcanized particles would not form a continuous network with the rest of the coating.

In view of the above comments, the Applicant maintains the previously submitted remarks, which are incorporated below for the Examiner's convenience.

Watanabe et al. fail to teach all elements of the current claims, in particular the limitation that the rubber latex is vulcanized. Watanabe et al. disclose a reinforcing glass fiber coated with a composition comprising a latex. However, the latex in Watanabe et al. is either self-crosslinking (column 3, lines 33-37) or may include a vulcanizing agent (column 3, line 51). In either case, the latex of Watanabe et al. is not a vulcanized rubber latex, merely a vulcanizable latex. Vulcanization, or crosslinking, *in situ* on the glass fiber appears to be a key principle of operation of the Watanabe et al. reinforcing fiber. In contrast, the invention of the current claims uses a different principle of operation in that the latex is already vulcanized. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

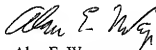
Moreover, the cited art does not appear to provide any suggestion as to whether a vulcanized latex would be operational for the purposes of Watanabe et al. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, the Applicant believes that the Examiner's *prima facie* case of obviousness fails.

The Applicants believe that the above remarks overcome all of the Examiner's rejections. Therefore, the Applicants request that the Examiner withdraw the rejections and issue a Notice of Allowance.

No petition or fee is believed due for the filing of this response. Any necessary petition should be considered provisionally made and any fee should be charged to Deposit Account 23-2053.

Respectfully submitted,

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